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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,073	09/12/2003	Richard Norris Dodge II	14,596	9799

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KIMBERLY-CLARK WORLDWIDE, INC.  
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NEENAH, WI 54956

EXAMINER
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REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/662,073	<b>Applicant(s)</b> DODGE ET AL.	
	<b>Examiner</b> Karin M. Reichle	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-15-04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For example:

***Specification******Drawings***

1. The drawings are objected to because the section lines shown in Figure 2 and those described on page 4 are inconsistent. Also Figure 6 is inconsistent with page 32, lines 11-14, i.e. where are the arrows? The arrow from 600 in Figure 7 should be dashed to denote underlying structure. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the composite, product and garment as claimed in claims 1-23 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Description*

3. The abstract of the disclosure is objected to because terminology which can be inferred, i.e. "The present invention...directed to", and legal terminology, i.e. "comprising", should be avoided. Correction is required. See MPEP § 608.01(b).

4. The use of the trademark LEXAN®, e.g. on page 32, has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be shown in all capital letters or with the symbol, but not both.

5. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: page 6, lines 13 and 33.

6. The disclosure is objected to because of the following informalities: The Summary of the Invention section on page 3, i.e. a description of the claimed invention, and the invention of the claims are not commensurate in scope. Also, as discussed supra, the description on page 3, lines 1-7 and page 32, lines 11-14 is not consistent with the Figures. At the very least, see the discussion infra, the description of the invention is inconsistent. For example, throughout the claims the invention is set forth as a composite including superabsorbent material which

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superabsorbent material has a specific Drop Penetration Value. However on pages 28-29 it is set forth that the Drop Penetration Value is a measure of hydrophobicity of a specific composite, see page 28, lines 22-24, which composite is not what is claimed. Therefore, at the very least a consistent description of what the invention is should be set forth throughout the specification.

Appropriate correction is required.

### ***Claim Objections***

7. Claims 10-11 and 21 are objected to because of the following informalities: in claims 10 and 21, line 1, "materials" should be --material--. Claim 11 is considered a claim depending from claim 1. However the preamble of this claim is inconsistent with that of claim 1.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

8. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As set forth in MPEP 2164.04, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. While the analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the written rejection. The language should focus on those factors reasons and evidence that lead the

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examiner to conclude the specification fails to teach how to make and use the claimed invention without undue experimentation or that the scope of enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

First, what is the claimed invention? As set forth in each of the independent claims, the invention is an absorbent composite which comprises superabsorbent material. The superabsorbent material, as best understood, is selected for use therein based on specific desired physical characteristics including its Absorption Time, liquid capacity, Drop Penetration Value and ½ Float Saturation. Therefore, the claims necessarily also define the invention by the tests or processes used to determine the selection of the superabsorbent used and the physical characteristics of the superabsorbent prior to combination with the fibers rather than setting forth specific superabsorbent compositions or specific superabsorbent/composite combination compositions of the end product, i.e. the claims are test characteristic claims and similar to product by process claims in that they do not claim the characteristics of the end product but rather a starting material.

Second, since the claimed physical characteristics of the superabsorbent prior to combination with the composite to form the end product must be determined, e.g., by a test used to measure such characteristic, the scope of the claims is enabled to the extent the test, i.e. the method and equipment or parameters thereof, measuring such characteristic is described or disclosed.

In the instant application, for example, as already discussed supra, the test for the determination of the Drop Penetration Value, as best understood the “Saline Drop Penetration Test”, does not evaluate the superabsorbent material alone as claimed, but rather is an evaluation

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of the hydrophobicity of a specific superabsorbent material/fluff composite, see page 28, lines 22-24, which is not required by the claim. A test for determining the Drop Penetration Value of the superabsorbent material has not been set forth. For another example, the claims require the superabsorbent material to have a specific  $\frac{1}{2}$  Float Saturation. While on pages 34-35 a "Floatability Test" has been set forth, nowhere in the description of such test is a property " $\frac{1}{2}$  Float Saturation" calculated or measured. For a third example, the claims require a superabsorbent material which has a specific liquid capacity and Absorption Time. While on pages 29-31, a test called "FAUZL" is set forth which measures "a final equilibrium absorption capacity" and "Absorption Time" using a timer capable of reading 120 minutes, it is not clear the liquid capacity claimed is the same as the "final equilibrium absorption capacity" described and it is described that there are instances where measurement of 200 minutes not just 120 minutes are required but equipment and the method of measurement have not been set forth for those instances. In other words, the tests used to measure the claimed physical characteristics are not described or disclosed at all or sufficiently, i.e. not enabled, and thus, the claims relying on such are not enabled.

Third, the claims set forth the physical characteristics desired of the starting SAM, as best understood, rather than the specific composition of the SAM or SAM/composite in the end product. Therefore, relying on Ex parte Slob, 157 USPQ 172, such claims could cover any conceivable combination of materials whether presently existing or which might be discovered in the future and which would impart the desired characteristic, i.e. the claims are too broad and indefinite since purport to cover everything having the characteristics regardless of its composition (It should be noted that 35 USC 101 sets forth "Whoever invents or discovers any



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new and useful...composition of matter...may obtain a patent therefor...title, i.e. does not included compositions that have yet to be invented and discovered.) Note also, for example, the specification at page 5, first full paragraph.

Fourth, and similarly, the claims do not set forth any structure of the composite but the superabsorbent, i.e. claims could cover any conceivable SAMmaterial either presently existing or which may discovered in the future. The claims do not set forth that the article is only SAM, i.e. the claims could cover any conceivable present or future absorbent material which includes at least SAM. The claims do not set forth a specific process by which the SAM of the article is made into the composite, i.e. the claims could cover any conceivable present or future process of making. In other words, the claims could cover any conceivable present or future absorbent composite end product which includes SAM. Note again Ex parte Slob, supra.

For these reasons and evidence, the examiner concludes the specification fails to teach how to make and use the claimed invention without undue experimentation or that the scope of enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

9. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As set forth in MPEP 2163, the issue of a lack of adequate written description may arise even for an original claim when an aspect of the claimed invention has not described with sufficient particularity such that one skilled in the art would recognize that the Applicant had

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possession of the claimed invention. The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art to or known to one of ordinary skill in the art. Further, as set forth in *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, the lack of adequate written description also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. As discussed in the preceding rejection, the tests which are essential or critical to the selection of the superabsorbent have not been disclosed or disclosed sufficiently, there is a lack of disclosure or claiming of any specific composite or end product composition, and the claims are too broad in that the claims cover any conceivable combination of ingredients either presently existing or which may be discovered in the future and which may impart the desired characteristics. Therefore, the claimed invention as a whole is not adequately described because the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art to or known to one of ordinary skill in the art and the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process (Note again, e.g., the first full paragraph on page 5 of the disclosure, i.e. a nonconventional approach using superabsorbent material which may include ranges of properties, i.e. properties defined by nonenabled tests, and, e.g., the Summary of the Invention section on page 3 and the paragraph bridging pages 5-6, especially the use of the terminology “may”, i.e. the composites may have superabsorbent materials which may include certain properties which may address certain deficiencies). Therefore, one skilled in the art would recognize that the Applicant did not have possession of the claimed invention.

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10. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For the reasons set forth supra, the claims are indefinite, vague and too broad, see Ex parte Slob, supra.

### ***Claim Language Interpretation***

11. The terminology “superabsorbent material” and “target area” will be interpreted as set forth on page 5, lines 13-16 and page 6, line 16. It is noted with respect to the latter that the terminology “the immediate vicinity” is considered relative absent claiming of specific dimensions. All other claim language will given their usual, i.e. dictionary, definition.

### ***Claim Rejections - 35 USC § 102/103***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 1-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dow PCT '818.

In regard to claims 1-4, see, e.g., abstract, page 3, last full paragraph, page 5, first through third full paragraphs, page 6, line 19-page 7, line 5, page 7, line 17-page 8, line 19, page 9, lines 5-7 and 16-20, and page 9, line 24-page 14, last line of '818, i.e. an absorbent composite comprising superabsorbent material as disclosed, e.g. superabsorbent material comprising partially neutralized acrylic acid, an internal crosslinking agent, a surface cross-linking agent, a capacity greater than 25/g/g and an Absorption Rate Index which is a time which equals about 10+10 a2 as claimed (It is noted that, especially due to the lack of enablement, it is unclear whether this time is the same as the claimed "Absorption Time" or not) Thus the Dow reference clearly teaches all the claimed structure and properties except for the characteristics of "Absorption Time", a Drop Penetration Value (It is noted that the composite of Dow may be a 50% superabsorbent/50% fluff composite), the ½ Float Saturation and the Gel Bed Permeability of the superabsorbent material as claimed. However, as noted supra Dow does teach similar materials for similar purposes and same or substantially similar properties, i.e. a capacity and an slow absorption time. It is also again noted such characteristics are those of the superabsorbent making up the claimed composite, and such material is, as best understood, tested prior to formation of such composite by the disclosed tests or processes i.e. the specific characteristics of such material of the end product composite are unknown. Therefore it is the Examiner's first position that for the reasons set forth supra, i.e. same or similar compositions, purposes, desired properties to accomplish such purposes, etc., there is reasonable factual basis to conclude that the structure of the Dow also inherently possesses superabsorbent material with the claimed test

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characteristics or values when tested according to Applicants' tests as best understood. In any case, the Examiner's second position, at the very least the general conditions of the claim are disclosed by Dow and it is not inventive, i.e. it would be obvious to one of ordinary skill in the art, to discover the optimum or workable ranges, i.e. Applicant's ranges, by routine experimentation, *In re Aller*, 105 USPQ 233 (CCPA 1955).

Claims 5-23: See the discussion of claims 1-4 *supra* as well as page 9, line 28-page 11, line 13, and thus Kellenberger '335 and '343, Meyer '603, Yarbrough '673 and Gustafsson '082 incorporated thereby which teach the SAM material distributed homogenously within a composite, e.g. '343, zoned within a composite, e.g. '335, 603, '673, '082, within a layer of a plurality of layers of a composite, e.g. '082, '673 or '603, alone or zoned in such layer, e.g. '673, zoned along a perimeter, e.g. '673, or laminated onto a substrate, e.g. '673.

### ***Double Patenting***

14. Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/660,982 (2005/0059762). Although the conflicting claims are not identical, they are not patentably distinct from each other because since the patent and the instant application have the same effective filing date, the one way *In re Vogel* test applies, i.e. are the claims of the instant application obvious in view of the other application claims? The answer is yes. The claims of the instant application are broader than the '982 claims. With regard to such broader aspects (e.g. application claims do not require specific composition of superabsorbent material set forth in '982 claims), once an applicant has received a patent for a species or more specific embodiment,

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he/she is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader, i.e. the patented claims anticipate the application claims. See *In re Goodman*, supra. It is noted that line 1 of the instant claim 1 requires a composite comprising superabsorbent, e.g. includes 100% superabsorbent. Therefore the application claims are considered to be a polymer as claimed by the '982 claims, see also discussion in the next paragraph.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/660982 in view of Dow '818. See discussion in paragraph 14 supra. Additionally claims 5-25 require features not claimed by the '982 claims in combination with the superabsorbent material. It is also noted that line 1 of claim 1 could be interpreted as requiring more than just superabsorbent material. However, see discussion of Dow '818, i.e. known to combine like superabsorbent with features such as those claimed in the instant claims to improve desired characteristics of any absorbent article, e.g. slow rate absorption. Therefore, to employ such claimed features in combination with the SAM of '982 would be obvious to one of ordinary skill in the art in view of the recognition that such features are known to be combined with such SAM to enhance characteristics desired in any absorbent article.

This is a provisional obviousness-type double patenting rejection.

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

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is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited but not applied was made of record in the '982 application set forth supra or also teaches similar superabsorbents and/or arrangements thereof.


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936.

The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
March 7, 2006